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05-06-04

Application 08/419,229
Petition to Expunge dated May 4, 2004
Reply to Office communication of March 23, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF PETITIONS

In re Application of

Thrift et al.

Serial No.: 08/419,229

Filed: 04/10/1995

For: **Voice Activated HyperMedia Systems Using Grammatical Metadata**

Docket No.: **TI-20205**

Examiner: **Dorvil, Richemond**

Art Unit: **2654**

Confirm. No.: **3703**

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PETITION TO EXPUNGE – 37 C.F.R. §1.59(b)

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Alexandria, VA 22313-1450

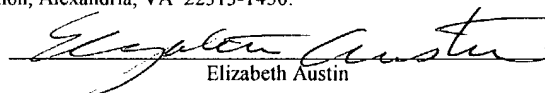
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Date of Deposit: **May 4, 2004**

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Elizabeth Austin

Applicants petition to expunge page 2, line 3 – page 3, line 4 of the Office Communication mailed on March 23, 2004, as being untimely, inappropriate, erroneous, and a violation of MPEP § 1302.14, for the reasons set forth below.

05/07/2004 AWONDAF1 00000130 200668 08419229

01 FC:1460 130.00 DA

TI-20205

ARGUMENT

THE FACTS:

1. A Notice of Allowance and Fee(s) Due was mailed to Applicants on December 30, 2003 (ATTACHMENT-1).
2. The Issue Fee paid on March 1, 2004 (ATTACHMENT-2).
3. The USPTO recorded the Issue Fee on March 1, 2004 (ATTACHMENT-3).
4. The Examiner mailed an Office communication on March 23, 2004. Beginning on page 2, line 3, and ending on page 3, line 4, the Office communication purports to limit the scope of independent claims 11 and 14. More specifically, the Examiner makes the statement: "With regard to independent claims 11 and 14, the claimed elements defined by "means-plus-function" format **are construed as being limited to the following corresponding structure or acts described in the specification ...**" (ATTACHMENT-4).

**REASONS WHY THE EXAMINER'S COMMENTS BEGINNING ON PAGE 2, LINE 3
AND ENDING ON PAGE 3, LINE 4 OF THE OFFICE COMMUNICATION OF MARCH
23, 2004 SHOULD BE EXPUNGED**

Applicants respectfully submit that the Examiner's comments beginning on page 2, line 3 and ending on page 3, line 4 of the Office Communication of March 23, 2004 are untimely, inappropriate, erroneous, and a violation of MPEP § 1302.14 and should be expunged from the file of the above-identified application for the following reasons:

A) THE EXAMINER DID NOT HAVE AUTHORITY TO REOPEN PROSECUTION OR TO ALTER THE GROUNDS FOR ALLOWANCE.

The U.S. Court of Appeals for the Federal Circuit, on August 9, 2002, vacated the Decision of the Board of Patent Appeal regarding the 35 U.S.C. 103 rejections of Claims 11-19 (ATTACHMENT-6). The Court specifically found, "The Board's decision is not supported by substantial evidence because the cited references do not support each limitation of claim 11" (see within ATTACHMENT-6, Appeal No. 01-1445, page 14, lines 3-5). The Court further found, "Appellants urge that there was also insufficient evidence in the record to support the examiner's and Board's conclusions regarding obviousness because the cited references do not support all of the limitation of claim 14. We agree that the Board's decision is not supported by substantial evidence" (see within ATTACHMENT-6, Appeal No. 01-1445, page 15, lines 11-15).

MPEP § 1216.01 (D) states the following:

In rare situations it may be necessary to reopen prosecution of an application after a decision by the Federal Circuit. Any Office action proposing to reopen prosecution after a decision by the Federal Circuit must be forwarded to the Office of the Assistant Commissioner for Patents for written approval, which will be indicated on the Office action.

No written approval from the Assistant Commissioner for Patents was indicated on the Office Action mailed on September 25, 2003 (ATTACHMENT-7) or on the Office communication mailed by the Examiner to Applicants on March 23, 2004 (ATTACHMENT-4). As a result, the Examiner was without authority under MPEP § 1216.01 (D) to restrict the scope of Claims 11 and 14 in the Office communication mailed by the Examiner to Applicants on March 23, 2004 (ATTACHMENT-4).

B) IT IS INAPPROPRIATE FOR THE EXAMINER TO SUO SPONTE ALTER THE PROSECUTION RECORD AFTER PROSECUTION ON THE MERITS HAS CLOSED.

A Notice of Allowance and Fee(s) Due was mailed by the USPTO on December 30, 2003 (see ATTACHMENT-1). Accordingly, prosecution on the merits of this application was closed on December 30, 2003. The Notice of Allowance contained no "Reasons for Allowance" purporting to narrow the scope of the claims.

Applicants paid the Issue Fee on the above Notice of Allowance on March 1, 2004 (see ATTACHMENT-2) which was recorded by the USPTO on March 1, 2004 (see ATTACHMENT-3).

The Examiner subsequently mailed the above-identified Office communication (see ATTACHMENT-4) on March 23, 2004 – more than three weeks after Applicants paid the issue fee AND almost three months after prosecution on the merits of this application was closed. Accordingly, the language contained on page 2, line 3 – page 3, line 4 of the Office communication mailed March 23, 2004 is untimely and inappropriate.

C) THE EXAMINER DID NOT HAVE AUTHORITY FROM THE BOARD OF APPEALS TO RESTRICT THE SCOPE OF CLAIMS 11 AND 14, AS SUGGESTED IN THE OFFICE COMMUNICATION.

The Examiner justifies limiting the scope of Claims 11 and 14 in the Office communication, as follows:

After a final review of the record of the application prior to issue, **it was determined that the record was incomplete vis-à-vis the board of Patent Appeals and Interference's directive to determine the scope of the means-plus-function language cited in the remand and to provide an analysis as to the patentability of the thus-construed claims in light of the prior art.** See Paper number 24, "REMAND TO THE EXAMINER," paragraph bridging pages three and four, citing In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(en banc). (Office Communication, page 2, lines 6-8)(emphasis added).

Applicants respectfully point out that in its REMAND TO THE EXAMINER, mailed on January 17, 2003, (ATTACHMENT-5) the Board made the following determination:

The above-identified application is hereby remanded to the Examiner for appropriate action **consistent with the decision of the CAFC and our comments below.**

Should the Examiner, after further consideration, decide that it is appropriate to reopen prosecution we make the following observations.

As stated in the CAFC decision of August 9, 2002, the court noted that independent claims 11 and 14 differ from independent claim 1, the obviousness rejection of which was upheld by the court, by adding a grammar creation capability to the claimed voice activated Hypermedia system. The court's decision concluded that the Board erred in affirming the obviousness rejection of independent claims 11 and 14 since the Examiner's assertion that ". . .[t]he use of grammar is old and well known in the art of speech recognition ..." was unsupported by any evidence. Accordingly, **in any future formulation of AN OBVIOUSNESS rejection of independent claims 11 and 14,** the Examiner is required, as a starting point, to provide clear evidence of the existence in the prior art of grammar creation capability in speech recognition systems. (Remand to the Examiner, page 2, lines 2-22).

Applicants respectfully point out that there is nothing in the decision of the CAFC (see ATTACHMENT-6) that suggests that the PTO should restrict Claims 11 and 14 in any manner, let alone the manner attempted by the Examiner in the above-identified Office communication. Moreover, the Board did not direct the Examiner to re-open prosecution – the Board left it up to the discretion of the Examiner. In the event the Examiner CHOSE to reopen prosecution the Board required that the Examiner's actions be consistent with both the decision of the CAFC and the comments provided by the Board in its Remand to the Examiner. The Board's comments applied to any obviousness rejection should the Examiner decide to re-open prosecution (see ATTACHMENT-5, page 2, line 2 – page 4, line 4).

In the Office Action mailed on September 25, 2003, the Examiner **dropped the rejection of Claims 11-19 under 35 U.S.C. 103(a) and substituted therefore new rejections under 35 U.S.C. § 112, first & second paragraphs** (ATTACHMENT-7). Group Director Powell subsequently refuted the newly cited 35 U.S.C. §112, first & second paragraph, rejections in an

Interview Summary dated December 12, 2003 (ATTACHMENT-8). With no remaining rejections, the application was allowed and Applicants paid the Issue Fee.

Applicants respectfully submit that once Examiner Chawan re-opened prosecution in the Office Action of September 25, 2003 and withdrew all the art rejection(s), the Examiner gave up any right (to the extent there ever was any) from the Board of Appeals, to rely upon authority from the Board in the Remand to the Examiner to justify restricting the scope of Claims 11 and 14.

D) THE EXAMINER'S ACTION OF RESTRICTING THE SCOPE OF CLAIMS 11 AND 14 IN THE OFFICE COMMUNICATION VIOLATES MPEP § 1302.14.

While not explicitly identified as "Reasons for Allowance", the Examiner has attempted to restrict the scope of Claims 11 and 14 through his determination in the Office communication (page 2, line 2 – page 3, line 4). MPEP § 1302.14 specifically states:

Where specific reasons are recorded by the Examiner, care must be taken to ensure that such reasons are **accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims.**

In light of the discussion above, it should be clear that the Examiner did not have authority from the Assistant Commissioner of Patents or the Board of Appeals to submit into the record restrictions to the scope of Claims 11 and 14, as set forth in the Office communication of March 23, 2004. Accordingly, the reasons provided by the Examiner for narrowing the scope of Claims 11 and 14 in the Office communication violate MPEP 1302.14 because they were not

authorized, are untimely, not accurate, not precise and they place unwarranted interpretations upon the claims.

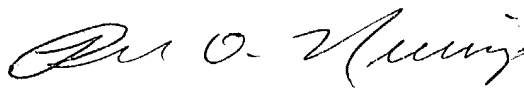
In view of the above traversal of the Examiner's comments in the Office communication of March 23, 2004, Applicants respectfully request the PTO to expunge page 2, line 3 – page 3, line 4 of the Office communication of March 23, 2004.

In the event this Petition to Expunge is granted and page 2, line 3 – page 3, line 4 of the Office communication of March 23, 2004, Applicants further request: 1) that Applicants' document entitled "Petition to Expunge" and all attachments; and 2) the document submitted herewith entitled "Objection to Communication from Examiner Purporting to Correct an Incomplete Record of the Application – After Issue Fee Paid" be expunged as being moot.

In the unlikely event that the facts of the Petition do not allow the Petition to be decided under 37 C.F.R. § 1.59(b), Applicants respectfully request the Petition to be considered under 37 C.F.R. § 1.182.

Pursuant to the requirements of 37 C.F.R. § 1.181(f), please charge the \$130.00 petition fee set forth in 37 C.F.R. § 1.17(h) to Deposit Account No. 20-0668. Three copies of this sheet are enclosed.

Respectfully submitted,



Ronald O. Neerings
Reg. No. 34,227
Attorney for Applicants

TEXAS INSTRUMENTS INCORPORATED
P.O. BOX 655474, M/S 3999
Dallas, Texas 75265
972/917-5299



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Philip R. Thrift, et al.

Serial No.: 08/419,229

Filed: 04/10/1995

For: Voice Activated Hypermedia Systems
Using Grammatical Metadata

Docket: TI-20205

Art Unit: 2654

Examiner: Dorvil, Richemond

Not. of All.: 12/30/2003

Conf. No.: 3703

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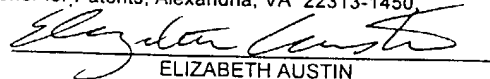
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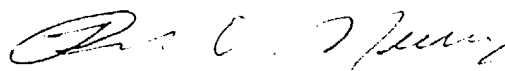
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ELIZABETH AUSTIN

Enclosed is the Issue Fee Transmittal form in the above-identified application.

Please charge the \$1,330 Issue Fee to the deposit account of Texas Instruments Incorporated, Account No. 20-0668. An original and two copies of this sheet are enclosed.

Respectfully submitted,



Ronald O. Neerings
Attorney for Applicants
Registration No. 34,227

Texas Instruments Incorporated
P. O. Box 655474, M/S 3999
Dallas, Texas 75265
(972) 917-5299

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail

Mail Stop ISSUE FEE
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 (703) 746-4000

or Fax

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence, including Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

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12/30/2003

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Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO, on the date indicated below.

Ronald O. Neerings, Reg. 34,227 (Depositor's name)
Ronald O. Neerings (Signature)
 3/01/04 (Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/419,229	04/10/1995	PHILIP R. THRIFT	TI-20205	3703

TITLE OF INVENTION: VOICE ACTIVATED HYPERMEDIA SYSTEMS USING GRAMMATICAL METADATA

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$0	\$1330	03/30/2004

EXAMINER	ART UNIT	CLASS-SUBCLASS
DORVIL, RICHEMOND	2654	704-275000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

- 1 Ronald O. Neerings
 2 Wade James Brady III
 3 Frederick J. Telecky, Jr.

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Texas Instruments Incorporated

Dallas, Texas U.S.A.

Please check the appropriate assignee category or categories (will not be printed on the patent); ☐ individual ☒ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

4b. Payment of Fee(s):

☒ Issue Fee☐ A check in the amount of the fee(s) is enclosed.☐ Publication Fee☐ Payment by credit card. Form PTO-2038 is attached.☐ Advance Order - # of Copies _____

☒ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number 20-0668 (enclose an extra copy of this form).

Director for Patents is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

(Authorized Signature)

Ronald O. Neerings, Reg. 34,227

(Date)

3/01/04

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Alexandria, Virginia 22313-1450.

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ATTACHMENT 2-2

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Applicant: Philip R. Thrift, et al.
Serial No.: 08/419,229
Filed: 04/10/1995
For: Voice Activated Hypermedia Systems
Using Grammatical Metadata



Docket: TI-20205
Art Unit: 2654
Examiner: Dorvil, Richemond
Not. of All.: 12/30/2003
Conf. No.: 3703

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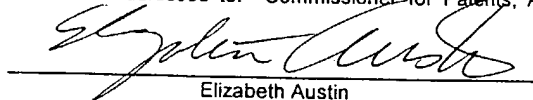
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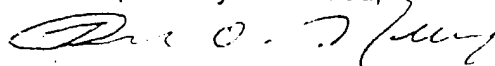

Elizabeth Austin

Submitted herewith is 1 sheet of formal drawings.

In response to the USPTO request for a proposed drawing correction dated December 30, 2003, Applicant's submitted formal drawings to the USPTO on April 27, 2001; USPTO receipt date of April 30, 2001. Applicants have no record of a proposed drawing correction filed on August 30, 1995; no drawing changes have been made to this application as of April 27, 2001. Therefore applicants believe no drawing correction is required.

No fees are believed to be due by the applicants; however, if the USPTO feels otherwise please charge the necessary fees to the deposit account of Texas Instruments Incorporated, Account 20-0668. This authorization is enclosed in triplicate.

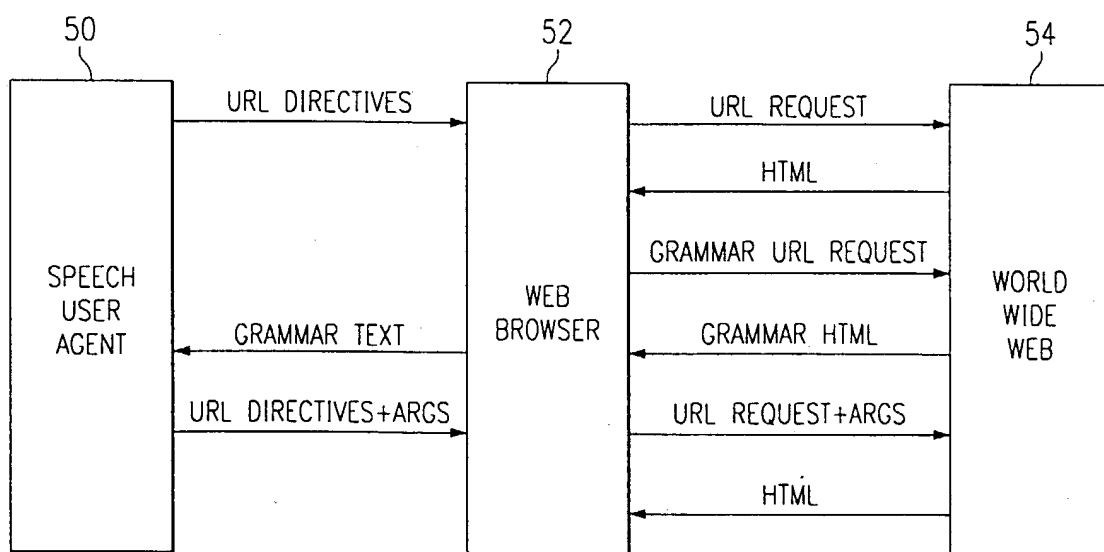
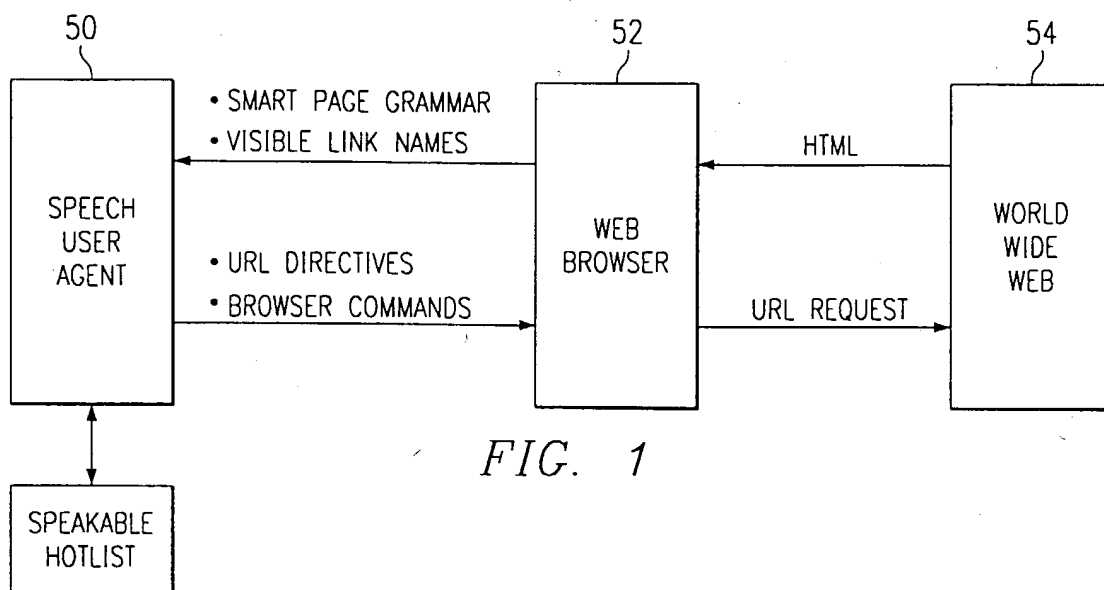
Respectfully submitted,



Ronald O. Neerings
Attorney for Applicants
Reg. No.: 34,227

Texas Instruments Incorporated
P. O. Box 655474, MS 3999
Dallas, Texas 75265
(972) 917-5299

1/1



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NAME OF INVENTOR(S): Phillip R. Thrift, and Charles T. Hemphill	SERIAL NUMBER: 08/419,229
TITLE OF INVENTION: Voice Activated Hypermedia Systems Using Grammatical Metadata	CONFIRMATION NO.: 3703
TI FILE NO.: TI-20205 DEPOSIT ACCT. NO.: 20-0668	
EXPRESS MAIL RECEIPT NO.: EV 333323877 US	
MAILED DATE: March 1, 2004 DATE DUE: March 30, 2004 ATTY/SECY: Ron Neerings / Elizabeth Austin	



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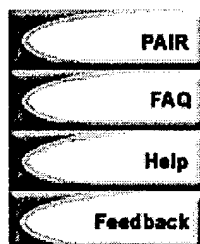
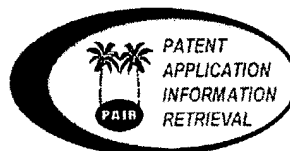
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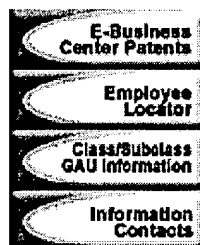
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Search results for application number:08/419,229			
Application Number:	08/419,229	Customer Number:	23494
Filing or 371(c) Date:	04-10-1995	Status:	Publications -- Issue Fee - Not Matched with File
Application Type:	Utility	Status Date:	03-05-2004
Examiner Name:	DORVIL, RICHEMOND	Location:	PUBS - INITIAL DATA CAPTURE (FILE UNAVAILABLE)
Group Art Unit:	2654	Location Date:	03-29-2004
Confirmation Number:	3703	Earliest Publication No:	-
Attorney Docket Number:	TI-20205	Earliest Publication Date:	-
Class/ Sub-Class:	704/275	Patent Number:	-
First Named Inventor:	PHILIP R. THRIFT, DALLAS, TX (US)	Issue Date of Patent:	-
Title Of Invention:	VOICE ACTIVATED HYPERMEDIA SYSTEMS USING GRAMMAT METADATA		

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Assignments**Search**

Continuity Data

Patent Term Extension History

Publication Review

File History	
Date	Contents Description
03-29-2004	Receipt into Pubs
03-26-2004	Workflow - File Sent to Contractor
03-26-2004	Receipt into Pubs
03-23-2004	Mail Miscellaneous Communication to Applicant
03-22-2004	Miscellaneous Communication to Applicant - No Action Count
03-01-2004	Issue Fee Payment Recorded
12-30-2003	Mail Notice of Allowance
12-30-2003	Mail Formal Drawings Required
12-29-2003	Formal Drawings Required
12-29-2003	Notice of Allowance Data Verification Completed
12-29-2003	Notice of Allowability
12-29-2003	Case Docketed to Examiner in GAU

ATTACHMENT 3-1

12-16-2003	Examiner Interview Summary Record (PTOL - 413)
09-25-2003	Mail Non-Final Rejection
09-24-2003	Non-Final Rejection
01-17-2003	Panel Remand to the Examiner by BPAI
08-09-2002	Court Processing Terminated
08-09-2002	Decision by CAFC - Remanded
11-06-2001	Appellant's Reply Brief
10-22-2001	Solicitor Answer to Appellant's Brief
09-07-2001	Appellant's Brief on Appeal
06-21-2001	Appeal to Court of Appeals
01-24-2002	Case Docketed to Examiner in GAU
01-24-2002	Case Docketed to Examiner in GAU
04-23-2001	Mail BPAI Decision on Reconsideration - Denied
04-23-2001	Dec on Reconsideration - Denied
03-19-2001	Request for Reconsideration of Appeal Dec
02-28-2001	Mail BPAI Decision on Appeal - Affirmed
02-28-2001	BPAI Decision - Examiner Affirmed
10-06-2000	Case Docketed to Examiner in GAU
07-17-2000	Mail Miscellaneous Communication to Applicant
07-17-2000	Miscellaneous Communication to Applicant - No Action Count
05-23-2000	Remand to the Examiner by BPAI
11-13-1997	Mail Examiner's Answer
11-10-1997	Examiner's Answer to Appeal Brief
09-10-1997	Date Forwarded to Examiner
09-09-1997	Appeal Brief Filed
07-07-1997	Notice of Appeal Filed
06-09-1997	Mail Advisory Action (PTOL - 303)
06-03-1997	Advisory Action (PTOL-303)
05-23-1997	Date Forwarded to Examiner
05-15-1997	Amendment after Final Rejection
03-27-1997	Mail Final Rejection (PTOL - 326)
03-25-1997	Final Rejection
02-05-1997	Date Forwarded to Examiner
01-17-1997	Response after Non-Final Action
01-17-1997	Request for Extension of Time - Granted
08-07-1996	Mail Non-Final Rejection
08-02-1996	Non-Final Rejection
11-09-1995	Case Docketed to Examiner in GAU
09-05-1995	Application Captured on Microfilm
08-23-1995	Application Is Now Complete
05-02-1995	Notice Mailed--Application Incomplete--Filing Date Assigned

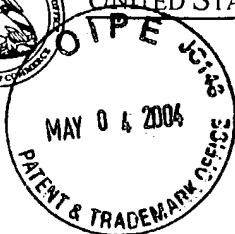
[|.HOME|](#)[|INDEX|](#)[|SEARCH|](#)[|eBUSINESS|](#)[|CONTACT US|](#)[|PRIVACY STATEMENT](#)

ATTACHMENT 3-2



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P.O. Box 1450
Alexandria, Virginia 22313-1450
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NOTICE OF ALLOWANCE AND FEE(S) DUE

23494

7590

12/30/2003

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

EXAMINER

DORVIL, RICHMOND

ART UNIT

PAPER NUMBER

2654

DATE MAILED: 12/30/2003

26

Issue Fee Due 3/30/04
Publication Fee Due 3/30/04

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/419,229	04/10/1995	PHILIP R. THRIFT	TI-20205	3703

TITLE OF INVENTION: VOICE ACTIVATED HYPERMEDIA SYSTEMS USING GRAMMATICAL METADATA

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$0	\$1330	03/30/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/419,229	04/10/1995	PHILIP R. THRIFT	TI-20205	3703
23494	7590	12/30/2003		
TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999 DALLAS, TX 75265				
			EXAMINER DORVIL, RICHEMOND	
			ART UNIT	PAPER NUMBER
			2654	26

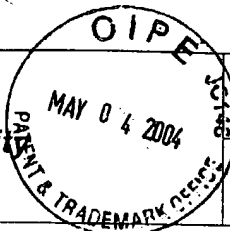
DATE MAILED: 12/30/2003

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b) (application filed prior to June 8, 1995)

This patent application was filed prior to June 8, 1995, thus no Patent Term Extension or Adjustment applies.

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

Notice of Allowability



Application No.

08/419,229

Examiner

Richmond Dorvil

Applicant(s)

THRIFT ET AL.

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

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Technology Center 2600

1. ☒ This communication is responsive to the interview Summary of November 08, 13 and December 16, 2003.
2. ☒ The allowed claim(s) is/are 11-19.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☒ including changes required by the proposed drawing correction filed 30 August 1995, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| <input type="checkbox"/> Notice of References Cited (PTO-892) | <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | <input type="checkbox"/> Examiner's Amendment/Comment |
| <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | <input type="checkbox"/> Other |

Richmond Dorvil
SPE
Art Unit: 2654

ATTACHMENT 1-3

Examiner-Initiated Interview Summary

Application No.

08/419,229

Applicant(s)

THRIFT ET AL

Examiner

Richemond Dorvil

Art Unit

2654

All Participants:

(1) Richemond Dorvil.

(2) Mr. Ronald Neerings.

Date of Interview: 16 December 2003

Type of Interview:

- ☒ Telephonic
☐ Video Conference
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☒ No

If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

None

Claims discussed:

1-10

Prior art documents discussed:

None

Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

Rejected claims 1-10 may be canceled by examiner's amendment

Part III.

- ☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

(Examiner/SPE Signature)

(Applicant/Applicant's Representative Signature - if appropriate)

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Ronald Neerings on December 16, 2003.

The application has been amended as follows:

In the claims:

Please cancel claims 1-10


RICHMOND DORVIL
SUPERVISORY PATENT EXAMINER



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/419,229	04/10/1995	PHILIP R. THRIFT	TI-20205	3703

23494 7590 03/23/2004

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

EXAMINER

DORVIL, RICHEMOND

ART UNIT PAPER NUMBER

2654

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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ATTACHMENT 4-1

PATENT DEPT

Notice of Allowability

Application No.

08/419,229

Examiner

Richemond Dorvil

Applicant(s)

THRIFT ET AL.

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the board remand to the examiner Jan. 17, 2003.
2. ☒ The allowed claim(s) is/are 11-19.
3. ☒ The drawings filed on 30 April 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
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5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☒ Other Commnet on BPAI remand 1/17/03.

Richemond Dorvil
SPE
Art Unit: 2654

ATTACHMENT 4-2

In response to counsel's request as to the validity of the prior drawing requirement, it is noted that such requirement was in error and no further response on applicants' part is necessary.

After a final review of the record of the application prior to issue, it was determined that the record was incomplete vis-a-vis the Board of Patent Appeals and Interferences' directive to determine the scope of the means-plus-function language cited in the remand and to provide an analysis as to the patentability of the thus-construed claims in light of the prior art. See Paper number 24, "REMAND TO THE EXAMINER," paragraph bridging pages three and four, citing In re Donaldson Co., 16 F. 3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc).

With regard to independent claims 11 and 14, the claimed elements defined by "means-plus-function" format are construed as being limited to the following corresponding structure or acts described in the specification as follows:

means for extracting a grammar are described in the specification as the web browser 52 of Fig. 2, a modified NCSA Mosaic "getting the link page name/URL pairs from the page" and correspond thereto;

means for modifying said grammar correspond to the BNF syntax defined in page 4 of the specification where, for example, "|" denotes alternatives, square brackets denote optionality, and parentheses provide grouping, see example in page 5. Smart Pages implemented to associate a grammar with a web page as disclosed in page 3, lines 23-26 of the specification, contain a reference to a grammar within a grammar that interprets the result of that grammar. Page 8, line 1 to page 9, line 25 further describe a directed Acyclic Graph (DAG) relationship,

Art Unit: 2654

page 7, line 8-17, used *as means for automatically producing an intelligent grammar from an information source*. An interface using interpretation schemes such as shell scripts, lex/yacc is used *as means for processing the grammar to produce a reference to a hypermedia source (URL)*.

Prosecution remains closed; this application is being forwarded to the Office of Publications for further issue processing. The undersigned regrets any inconvenience caused by the delay in completing the requirements of the remands.

Conclusion

Any inquiry concerning this communication should be directed to Richemond Dorvil at telephone number (703) 305-9645.



Richemond Dorvil
SPE
Art Unit 2654

RON



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP R. THRIFT
and
CHARLES T. HEMPHILL

Appeal No. 1998-1109
Application No. 08/419,229 *TI 20205*

ON BRIEF



Before JERRY SMITH, FLEMING, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

REMAND TO THE EXAMINER

On August 9, 2002, the United States Court of Appeals for the Federal Circuit issued a decision on an appeal taken from the decision of the Board of Patent Appeals and Interferences affirming the Examiner's rejection of claims 1-19 for obviousness under 35 U.S.C. § 103. In this decision on appeal, the court affirmed the Board's decision as to claims 1-10, but vacated and remanded for further consideration the Board's decision affirming

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Appeal No. 1998-1109
Application No. 08/419,229

the Examiner's rejection of claims 11-19. See In re Thrift, 298 F.3d 1357, 63 USPQ2d 2002 (Fed. Cir. 2002). The above-identified application is hereby remanded to the Examiner for appropriate action consistent with the decision of the CAFC and our comments below.

Should the Examiner, after further consideration, decide that it is appropriate to reopen prosecution, we make the following observations.

As stated in the CAFC decision of August 9, 2002, the court noted that independent claims 11 and 14 differ from independent claim 1, the obviousness rejection of which was upheld by the court, by adding a grammar creation capability to the claimed voice activated Hypermedia system. The court's decision concluded that the Board erred in affirming the obviousness rejection of independent claims 11 and 14 since the Examiner's assertion that " . . . [t]he use of grammar is old and well known in the art of speech recognition . . . " was unsupported by any evidence. Accordingly, in any future formulation of an obviousness rejection of independent claims 11 and 14, the Examiner is required, as a starting point, to provide clear evidence of the existence in the prior art of grammar creation capability in speech recognition systems. In addition, the

Examiner must address the particular limitations of independent claim 11 which requires the extracting, modifying, and processing of grammar as part of interaction with a hypermedia source, and independent claim 14 which sets forth a requirement of grammar production from textual representation of information resource links.¹

Further, as part of the review of this application, the Examiner should recognize that the language of claims 11-19 is presented in "means-plus-function" format. When claimed elements are defined by "means-plus-function" format, they are interpreted as being limited to the corresponding structure described in the specification or the equivalents thereof consistent with 35 U.S.C. § 112, paragraph 6. In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc); See also Manual of Patent Examining Procedure (MPEP) § 2181 (8th Ed., August 2001) for the guideline for invoking 35 U.S.C. § 112, sixth paragraph. The Examiner must therefore determine the precise scope of the appealed claims consistent with 35 U.S.C.

¹ In particular, with regard to the limitations of independent claim 14, the Examiner should review the Schmandt reference and the discussion of the "Xspeak II" enhancement beginning at page 54 which appears to suggest the production of grammar to aid in the interaction with particular applications.

Appeal No. 1998-1109
Application No. 08/419,229

§ 112, sixth paragraph, and must consider how the art of record, as well as any newly discovered prior art, may be applicable to the determination of the patentability of properly construed claims 11-19.

APPROPRIATE ACTION

We remand this application to the Examiner for action consistent with the above.

Appeal No. 1998-1109
Application No. 08/419,229

This application, by virtue of its "special" status requires immediate action. See (MPEP) 708.01 (8th Ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this application.

REMANDED

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)

Michael R. Fleming

MICHAEL R. FLEMING)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Joseph F. Ruggiero

JOSEPH F. RUGGIERO)
Administrative Patent Judge)

JFR:hh

Appeal No. 1998-1109
Application No. 08/419,229

RUBEN C. DELEON
TEXAS INSTRUMENTS, INC.
P.O. BOX 655474, M/S 219
DALLAS, TX 75265

United States Court of Appeals for the Federal Circuit

01-1445
(Serial no. 08/419,229)

2008

IN RE PHILIP R. THRIFT and CHARLES T. HEMPHILL

Judgment

ON APPEAL from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

in CASE NO(S).

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED, VACATED AND REMANDED

ENTERED BY ORDER OF THE COURT

DATED AUG 9 2002

Jan Horbaly / 142
Jan Horbaly, Clerk

ISSUED AS A MANDATE: SEPTEMBER 30, 2002

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

NOTICE OF ENTRY OF JUDGMENT ACCOMPANIED BY OPINION

OPINION FILED AND JUDGMENT ENTERED: 08/09/02

The attached opinion announcing the judgment of the court in your case was filed and judgment was entered on the date indicated above. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing en banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

No costs were taxed in this appeal.

Regarding exhibits and visual aids: Your attention is directed to FRAP 34(g) which states that the clerk may destroy or dispose of the exhibits if counsel does not reclaim them within a reasonable time after the clerk gives notice to remove them. (The clerk deems a reasonable time to be 15 days from the date the final mandate is issued.)

JAN HORBALY
Clerk

cc: RONALD O. NEERINGS
JOHN M. WHEALAN

IN RE THRIFT, 01-1445
PTO - 08/419,229

ATTACHMENT 6-2

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United States Court of Appeals for the Federal Circuit

01-1445
(Serial no. 08/419,229)

IN RE PHILIP R. THRIFT and CHARLES T. HEMPHILL

Ronald O. Neerings, Texas Instruments Incorporated, of Dallas, Texas, argued for appellants. Of counsel on the brief was Jay M. Cantor, Baker & Botts L.L.P., of Washington, DC. Of counsel was Michael K. Skrehot, Texas Instruments Incorporated, of Dallas, Texas.

Joseph G. Piccolo, Associate Solicitor, United States Patent and Trademark Office, of Arlington, Virginia, argued for the Director of the United States Patent and Trademark Office. With him on the brief were John M. Whealan, Solicitor, and Cynthia C. Lynch, Associate Solicitor.

Appealed from: United States Patent and Trademark Office
Board of Patent Appeals and Interferences

United States Court of Appeals for the Federal Circuit

01-1445
(Serial no. 08/419,229)

IN RE PHILIP R. THRIFT and CHARLES T. HEMPHILL

DECIDED: August 9, 2002

Before BRYSON, GAJARSA, and DYK, Circuit Judges.

DYK, Circuit Judge.

Philip R. Thrift and Charles T. Hemphill appeal from the decision of the Board of Patent Appeals and Interferences ("Board") affirming the examiner's rejection of claims 1-19 for obviousness under 35 U.S.C. § 103. Ex parte Thrift, No. 1998-1109 (Bd. Pat. App. & Int. Feb. 28, 2001) ("Decision on Appeal"); Ex parte Thrift, No. 1998-1109 (Bd. Pat. App. & Int. Apr. 24, 2001) ("Decision on Request for Rehearing"). We affirm the Board's decision with respect to claims 1-10, but vacate the Board's decision with respect to claims 11-19, and remand for further proceedings with respect to these claims.

BACKGROUND

On April 10, 1995, Thrift and Hemphill filed U.S. Patent Application No. 08/419,229 (the "'229 application") entitled "Voice Activated HyperMedia Systems Using

Grammatical Metadata." On June 6, 1995, Thrift and Hemphill assigned their entire rights in the invention described in the '229 application to Texas Instruments, Inc. ("TI"), making TI the real party in interest in this proceeding.

The parties focus on the three independent claims as amended: claims 1, 11, and 14. Appellants conceded before the Board that dependent claims 2-4 stand or fall with claim 1. Appellants' Br. to Board at 3. Moreover, claims 5-10 are ultimately dependent on claim 1; claims 12 and 13 are dependent on claim 11; and claims 15-19 are ultimately dependent on claim 14. Although appellants urge that the examiner rejected claims 5-10, 12, 13, and 15-19 without providing any evidence of the additional features of these claims, appellants fail to identify the specific errors in the Board's decision or even the features of these claims that would allow them to overcome an obviousness rejection. Such a conclusory argument by appellants is not sufficient to raise separate issues on appeal with respect to the dependent claims. Thus, all of the dependent claims must stand or fall with their respective independent claims 1, 11, and 14.

The independent claims provide as follows:

1. A voice activated Hypermedia system using grammatical metadata, said system comprising:
 - a. a speech user agent;
 - b. a network browsing module; and
 - c. an information resource located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource.
11. A voice activated Hypermedia system using grammatical metadata, said system comprising:
 - a. a speech user agent;
 - b. a network browsing module;

- c. an information resource located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource;
- d. a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source;
- e. a means for modifying said grammar;
- f. a means for automatically producing an intelligent grammar from said information resource; and
- g. a means for processing said grammar to produce a reference to said hypermedia source.

14. A voice activated Hypermedia system using grammatical metadata, said system comprising:

- a. a speech user agent;
- b. a browsing module;
- c. an information resource; and
- d. a means for producing a grammar from textual representation of links to said information resource.

'229 application at 13-14; Jan. 14, 1997 Amendment at 1-3.

The invention recited in claim 1 comprises a speech interface (i.e., the speech user agent) that allows users to access information located on a computer network using a network browsing module, a software tool used to locate database sites on a network. Using the speech interface, an individual can use voice commands to activate the browser and access information located on the computer network, such as a desired Hypertext Markup Language ("HTML") page. The user can access various links on a given HTML page by speaking aloud the link names.

Claims 11 and 14 add the ability to create a "grammar." A grammar is an established set of standard query words. '229 application at 11. According to the '229 application, each user can construct a grammar and associate it with a Uniform Resource Location ("URL"), creating a "Speakable Hotlist." Id. at 4. A "Speakable Hotlist" allows the user to access a number of different URLs by just saying a phrase.

For example, saying the phrase "how does the weather look today" could immediately link the user to the URL <<http://www.washingtonpost.com/weather>>. Id. at 5.

Claim 11 differs from claim 1 by adding a number of means limitations providing the functions of extracting, modifying, dynamically producing, and processing the grammar. Claim 14 differs from claim 1 by reciting "a means for producing a grammar from textual representation of links to [the] information resource." '229 application at 14.

On August 7, 1996, the examiner issued a first Office Action, which rejected claims 1-19 under "35 U.S.C. § 103 as being unpatentable over Stefanopoulos et al. [U.S. Patent No. 5,333,237] and in view of Schmandt [Chris Schmandt et al., Augmenting a Window System with Speech Input, Computer Magazine, Aug. 1990, at 50 ("Schmandt")]. . . ." Aug. 7, 1996 Office Action at 3.

These prior art references relate most directly to claim 1. U.S. Patent No. 5,333,237 (the "'237 patent") issued to Stefanopoulos, et al. ("Stefanopoulos") is entitled "Hypermedia Structured Knowledge Base System." Stefanopoulos is directed to a hypermedia-structured expert system (i.e., a browser software system) that searches and accesses archived electronic documents. '237 patent, col. 1, ll. 11-15. The disclosed invention "incorporates the ability to have both an electronic-based document and an expert system [i.e., a browser software system] coexist within a single computer program." Id. at col. 2, ll. 52-54. The browser software system and the electronic documents are interlinked so that the user can move easily between them. Id. at col. 2, ll. 55-57. Stefanopoulos discloses the processing of user action based on embedded intelligence and returning results to the user. Id. at col. 6, ll. 52-54.

Stefanopoulos also discloses an advice (or help) scheme that provides troubleshooting advice to the user, id. at col. 6, ll. 55-68, in addition to disclosing the textual representation of hypertext links. Id. at col. 6, ll. 32-42, col. 7, ll. 18-38.

Another pertinent prior art reference is an article entitled "Augmenting a Window System with Speech Input," authored by Chris Schmandt, Mark S. Ackerman, and Debby Hindus. The Schmandt reference is directed to controlling a windows system by speech input. Schmandt at 50. Speaking a window's name will move the window to the front of the screen and move the cursor into that window. Id. Schmandt describes how speech can be used to navigate in a windows system so that speech actually "assume[s] some of the functions currently assigned to the mouse." Id. Schmandt describes two speech interfaces: "Xspeak" and "Xspeak II." Id. at 52, 54. Xspeak rearranges windows by "associat[ing] windows with voice templates, [i.e.,] words trained and stored in the recognizer and constituting its vocabulary." Id. at 52. Xspeak II improves on the speech interface of the original Xspeak system by making two changes: (1) "improv[ing] recognition rates . . . [by] add[ing] the ability to create subtemplates;" and (2) "includ[ing] a specialized language, G-XL, to facilitate general-purpose handling of the window[s] system." Id. at 54. In other words, "Xspeak II allows greater flexibility in the speech interface." Id.

On August 7, 1996, the examiner concluded that claim 1 was obvious because Stefanopoulos taught a "hypermedia structured knowledge base system" comprising a browsing module and an information resource, and Schmandt taught a speech interface that served as a navigational tool. Aug. 7, 1996 Office Action at 3. The examiner's motivation to combine the two references was that the speech interface to the Web

"allows easy access to information on the Web by reducing manual intervention [i.e., the use of keyboard], and . . . is user friendly." Id.

Although the examiner did not find that Stefanopoulos and Schmandt disclosed the grammar-creation capability added in claims 11 and 14, the examiner also rejected both of these claims, noting that "[t]he use of grammar is old and well known in the art of speech recognition as a means of optimization which is highly desirable." Id. at 5. The examiner concluded that the additional features specified in the dependent claims were also unpatentable over the cited references, and ultimately rejected claims 1-19 under 35 U.S.C. § 103.

On January 14, 1997, appellants amended claims 1-5, 7-9, and 11 to attempt to overcome the obviousness rejections. Most pertinently, the "information resource" of claim 1 was further defined as "located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource." Jan. 14, 1997 Amendment at 2. This limitation was also added to claim 11 in addition to amending element (d) of claim 11 to recite "a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source." Id. at 3 (emphasis indicating added language).

On March 27, 1997, in response to the amendment, the examiner issued a final Office Action, maintaining the rejection of claims 1-19 of the '229 application. Mar. 27, 1997 Final Office Action at 2. The examiner found the claims obvious, even in light of the "newly added limitation of '... an information resource located on a computer network . . .,'" because Schmandt "teach[es] a window[s] system that links together workstations," and "[i]t would have been obvious to one with ordinary skill in the art at

the time of invention that workstations linked together form a network and are served by an information resource, because an artisan would recognize that this is an efficient usage of space available." Id. at 2-3.

The Board affirmed the examiner's rejection of all 19 claims. Decision on Appeal at 10. The Board concluded with respect to independent claim 1, "the skilled artisan would have been motivated and found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs." Id. at 5. The Board sustained the examiner's rejection of dependent claims 2-4 as falling with claim 1. Id. at 8. The Board further noted that "independent claims 11 and 14 are similar to independent claim 1 . . . but add limitations directed to the construction and extraction of grammar related features as part of the speech user agent." Id. at 9. The Board concluded with respect to claims 5-19, "the Examiner's reasoning is sufficient to shift the burden to Appellants to come forward with evidence and/or arguments to rebut the Examiner's position." Id. Although the Board acknowledged that "the applied references do not explicitly disclose several of the various features of claims 5-19," it sustained the rejection of these claims because "Appellants' minimal arguments do not address the Examiner's position of obviousness or inherency with respect to the features recited in these claims." Id. at 10.

On rehearing, the Board denied appellants' request to reconsider its previous decision rejecting claims 1-19. Decision on Request for Rehearing at 7. The Board once again noted the sufficiency of the examiner's reasoning in proving a prima facie

case of obviousness and the lack of evidence to rebut the examiner's position. Id. at 6-7.

We have jurisdiction over this appeal pursuant to 28 U.S.C. § 1295(a)(4)(A).

DISCUSSION

I

"The ultimate determination of whether an invention would have been obvious under 35 U.S.C. § 103(a) is a legal conclusion based on underlying findings of fact." In re Kotzab, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). The Board's ultimate determination of obviousness is reviewed without deference; the Board's underlying factual findings are reviewed for substantial evidence. Id.

II

Appellants urge that their invention described in the '229 application was not obvious under 35 U.S.C. § 103 over Stefanopoulos in view of Schmandt because (1) the record does not support the Board's determination that the examiner made a prima facie case of obviousness of claim 1; and (2) the Board failed to provide evidence of the presence of key limitations of claims 11 and 14 in the prior art. We address each argument in turn.

A. Prima Facie Case of Obviousness and Claim 1

To establish a prima facie case of obviousness, the Board must, inter alia, show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "The motivation, suggestion or teaching may come explicitly from statements in

the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” Kotzab, 217 F.3d at 1370, 55 USPQ2d at 1317.

The Board agreed that the examiner had satisfied his burden of presenting a prima facie case of obviousness with respect to claim 1. Decision on Appeal at 5. The Board explained:

With respect to independent claim 1, the Examiner, as the basis for the obviousness rejection, proposes to modify the disclosed Hypermedia structured expert system of Stefanopoulos which, in the Examiner's view, discloses the claimed invention except for the speech user agent. To address this deficiency, the Examiner turns to Schmandt which discloses the use of speech input to navigate through a multiple window based computer system display. In the Examiner's analysis . . . the skilled artisan would have been motivated and found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system [i.e., here the browser software system] of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.

. . . In our view the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness.

Decision on Appeal at 4-5 (emphasis added).

Appellants appear to concede that Stefanopoulos discloses all of the limitations of the claimed invention except the “speech user agent.” However, appellants urge that Schmandt does not disclose a “speech user agent.” Appellants define a “speech user agent” as an agent that “dynamically creates the vocabulary, grammar and actions that are possible for the user to use in a given situation.” Appellants’ Br. at 35 (emphasis added).

When examining claims for patentability, claims are interpreted as broadly as is reasonable and consistent with the specification. See, e.g., In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Because claim 1 uses the general term

"speech user agent" without any modifiers, appellants' limiting interpretation of this phrase is inappropriate, particularly in light of the grammar-creation capability separately recited in claims 11 and 14. Instead, we interpret the phrase "speech user agent" consistent with its plain meaning: an interface that allows the user to interact with the system by speaking. See IBM Dictionary of Computing 638 (10th ed. 1994) (defining "speech recognition" as "[t]he recognition of voice communication as a series of words or sentences"); Van Nostrand Reinhold Dictionary of Information Technology 473 (3d ed. 1989) (defining "speech recognizer" as "[i]n man-machine interfaces, a system that receives spoken word inputs and identifies the message. The system output can then be used to initiate appropriate actions or responses."); Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) ("The general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning."). Although an applicant may be his own lexicographer, Markman v. Westview Instruments, Inc., 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996), nothing in the specification defines the phrase "speech user agent" differently from its ordinary meaning. Applying the above definition, Schmandt clearly discloses a "speech user agent" because the reference specifically describes "Xspeak," a speech interface with the windows environment.

Appellants also argue that even if Schmandt discloses a "speech user agent," there is no suggestion or motivation to combine Schmandt and Stefanopoulos. Recently, in In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), we held that the Board's reliance on "common knowledge and common sense" did not fulfill the

agency's obligation to cite references to support its conclusions. Id. at 1344, 61 USPQ2d at 1434. Instead, the Board must document its reasoning on the record to allow accountability. Id. at 1345, 61 USPQ2d at 1435. This documentation also allows effective judicial review. Id.

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by In re Lee. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have "found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs." Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that "allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment." Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that "there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art." '237 patent, col. 4, ll. 34-38.

Appellants also argue that Schmandt discloses only a pre-programmed grammar. Because the construction of "speech user agent" does not require an agent that dynamically changes grammar and vocabulary, but only an agent that allows the user to interact with the system by speaking, we conclude that Schmandt adequately

ATTACHMENT 6-14

discloses a speech user agent as required by claim 1 of the '229 application. Appellants further urge that Schmandt's invention is directed to navigation in a windows system, not the web-browsing environment of the present invention. However, the Board properly concluded that the present invention is not limited to a web-browsing environment, stating that "the language of the appealed claims reveals only a recitation of a 'computer network' with no recitation of any remote accessing of a database or any limitation as to database complexity or the internet." Decision on Appeal at 8. Appellants also argue that the prior art references revealed no reasonable expectation of success in carrying out the invention; however, the Board found that this issue had not been properly raised. Finally, we are not persuaded that Schmandt does not suggest the combination because it only refers to speech recognition as substituting for the mouse and not the keyboard. Accordingly, the Board's conclusion that the invention recited in claim 1 was obvious is well supported.

For these reasons, we affirm the Board's decision as to independent claim 1 and dependent claims 2-10.

B. Evidence of Key Limitations of Claims 11 and 14 in the Prior Art

1. Claim 11

As noted above, claim 11 differs from claim 1 in that claim 11 adds grammar-creation capability features including a means for extracting a grammar from a hypermedia source; a means for modifying the grammar; a means for dynamically producing the grammar; and a means for processing the grammar to produce a reference to a specific hypermedia source. In the August 1996 Office Action, the examiner summarily rejected claim 11's grammar-creation capability limitations, stating

that "[t]he use of grammar is old and well known in the art of speech recognition as a means of optimization which is highly desirable." Aug. 7, 1996 Office Action at 5. The examiner's final Office Action generally affirmed his initial conclusion as to obviousness, without specifically discussing the grammar features. Mar. 27, 1997 Final Office Action at 2. The Board subsequently affirmed the examiner's decision to reject claim 11, noting that the examiner set forth sufficient reasoning for asserting the obviousness or inherent nature of each of the claimed features, and therefore, "the Examiner's reasoning is sufficient to shift the burden to Appellants to come forward with evidence and/or arguments to rebut the Examiner's position." Decision on Appeal at 9; accord Decision on Request for Rehearing at 6.

Appellants urge that this rejection was improper because there is no evidence in the record to prove that the following limitations of claim 11 would be obvious:

- d. a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source;
- e. a means for modifying said grammar;
-
- g. a means for processing said grammar to produce a reference to said hypermedia source.

Even if all of the limitations of claim 11 were present in the prior art, appellants urge that there is no teaching or suggestion supporting the combination of these references.

We agree with appellants that the Board's ground of rejection is simply inadequate on its face. The Board sustained the examiner's very general and broad conclusion of obviousness based on his finding that "[t]he use of grammar is old and well known in the art of speech recognition as a means of optimization which is highly desirable." Aug. 7, 1996 Office Action at 5; accord Decision on Request for Rehearing at 6. Although this statement is likely true, it fails to address the grammar-creation

capability limitations of claim 11. While the examiner's statement generally addresses the use of grammar, it does not discuss the unique limitations of extracting, modifying, or processing the grammar to interact with hypermedia sources. The Board's decision is not supported by substantial evidence because the cited references do not support each limitation of claim 11. See In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1443 (Fed. Cir. 1991).

The Patent Office ("PTO") on appeal does not even defend the Board's rejection of claim 11 on the merits. Rather, it urges that appellants did not properly raise the grounds for sustaining the patent before the Board. The PTO's argument seems weak at best because appellants' brief to the Board specifically discusses the alleged failure of the Schmandt and Stefanopoulos references to teach the claimed invention of claim 11. Despite language in the Board's reconsideration decision faulting appellants for failure to raise issues before the Board,¹ we do not read the Board's decisions on appeal or reconsideration as resting on this ground. Rather, the Board sustained the examiner's rejection on the merits.

In SEC v. Chenery Corp., 332 U.S. 194, 196 (1947), the Supreme Court held that

a reviewing court, in dealing with a determination or judgment which an administrative agency alone is authorized to make, must judge the propriety of such action solely by the grounds invoked by the agency. If those grounds are inadequate or improper, the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis.

¹ The Board noted that "neither of [Appellants' arguments regarding motivation were] made by Appellants in the Brief. An argument not timely made is an argument waived." Decision on Request for Rehearing at 4.

Here the Chenery rule is implicated because the Board failed to provide an adequate ground for sustaining the rejection of claim 11 in either its decision on appeal or its decision on request for rehearing. See also SKF USA Inc. v. United States, 254 F.3d 1022, 1028 (Fed. Cir. 2001).

Therefore, because the Board did not hold that appellants' arguments were untimely and did reach the merits of claim 11 but failed to provide an adequate basis for rejecting this claim, we vacate and remand for further proceedings before the Board as to independent claim 11 and dependent claims 12 and 13.

2. Claim 14

Since the limitations of claims 11 and 14 are very similar, the examiner rejected claim 14 on the same grounds as he rejected claim 11. Appellants urge that there was also insufficient evidence in the record to support the examiner's and Board's conclusions regarding obviousness because the cited references do not support all of the limitations of claim 14. We agree that the Board's decision is not supported by substantial evidence. Again, in its brief to this court, the PTO attempts to sustain the actions of the Board on grounds not articulated in the Board's decision, relying on Schmandt to defend the rejection of claim 14. The PTO claims that Schmandt's Xspeak II system discloses the grammar limitation of claim 14: "a means for producing a grammar from textual representation of links to said information resource." The PTO further contends that Schmandt provides the motivation to combine a speech user agent such as Xspeak II with the information resource described in Stefanopoulos because Xspeak II provides the benefits of decreased manual input and improved recognition rates.

Whatever merit there is to the PTO's defense of the rejection of claim 14 raised in its brief submitted to this court, that ground does not appear in the Board's decision and may not be the basis for affirmance. See Chenery, 332 U.S. at 196; In re De Blauwe, 736 F.2d 699, 705 n.7, 222 USPQ 191, 196 n.7 (Fed. Cir. 1984) ("[T]he Solicitor cannot raise a new ground of rejection or apply a new rationale to support a rejection in appeals from decisions of the board."). We vacate and remand for further proceedings as to independent claims 14 and dependent claims 15-19.

CONCLUSION

For the foregoing reasons, we affirm the Board's decision as to claims 1-10, and we vacate and remand the Board's decision as to claims 11-19 for further proceedings consistent with this opinion.

COSTS

No costs.

1 Ron



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/419,229	04/10/1995	PHILIP R. THRIFT	TI-20205	3703

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EXAMINER

CHAWAN, VIJAY B

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 09/25/2003

25

Amendment 12/28/03

Please find below and/or attached an Office communication concerning this application or proceeding.

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PATENT DEPT

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Office Action Summary	Application No.	Applicant(s)	
	08/419,229	THRIFT ET AL.	
	Examiner	Art Unit	
	Vijay B. Chawan	2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

ATTACHMENT 7-2

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, Applicant's claimed;

- means for extracting grammar from a hypermedia source on said information resource for future reference to said source;
- means for modifying said grammar;
- a means for automatically producing an intelligent grammar from said information resource; and,
- a means for processing said grammar to produce a reference to said hypermedia source;

and,

In claim 14, Applicant's claimed,

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- a means for producing a grammar from textual representation of links to said information resource.

The specification shows a Smart page and defines Smart page as containing a reference to a grammar (pages 7-8). However, the specification, in pages 1-12, fails to show any corresponding structure of a means for extracting, modifying, producing, and processing grammar to produce a reference to a hypermedia source. The specification does not disclose adequate structure for performing the recited function, thereby failing to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. Because no structure disclosed in the embodiments of the invention actually performs the claimed function, the specification lacks the corresponding structure as required by 35 U.S.C. 112, 6th paragraph, and fails to comply with 35 U.S.C. 112, 2nd paragraph.

"If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second

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paragraph. Budde v. Harley-Davidson, Inc., 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001); Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 296 F.3d 1106, 1115-18, 63 USPQ2d 1725, 1731-34 (Fed. Cir. 2002). MPEP 2100-217.

The written description is objected to in light of 35 U.S.C. 112 1st paragraph for failing to show any corresponding structure of the claimed means for extracting, modifying, producing, and processing grammar to produce a reference to a hypermedia source.

See In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Conversely, the invocation of 35 U.S.C. 112, sixth paragraph does not exempt an applicant from compliance with 35 U.S.C. 112, first and second paragraphs. See Donaldson, 16 F.3d at 1195, 29 USPQ2d at 1850; Knowlton, 481 F.2d at 1366, 178 USPQ at 493. See MPEP 2100-217-218.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter,

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which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to show any corresponding structure of the claimed means for extracting, modifying, producing, and processing grammar to produce a reference to a hypermedia source. The specification does not disclose adequate structure for performing the recited functions as required by 35 U.S.C. 1st paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vijay B. Chawan whose telephone number is (703) 305-3836. The examiner can normally be reached on Monday Through Thursday 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (703) 305-9645. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

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Vijay B. Chawan
Primary Examiner
Art Unit 2654

Vbc

Richemond Dorvil
SPE Art Unit 2654



UNITED STATES
PATENT AND
TRADEMARK OFFICE

To: RON NEERING Fax: 972 917 4418
From: _____ Date: _____
Re: INT. SUM. Pages: 1 + 811 cover
☐ Urgent ☒ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

Notes:

TI-20205

2121 Crystal Drive, Technology Center 2600, Park 2 - 8A25, Arlington, VA 22309
Phone: (703) 305-4800 Fax: (703) 308-5401

December 12, 2003

Serial No: 08/419,229
Filed: April 10, 1995


Interview Summary

The following summarizes telephone conversations on November 8 and 13, 2003 between Mr. Ronald Neerings, of record, and Mark R. Powell, Director Technology Center 2600.

Mr. Neerings telephoned and inquired as to the status of the above-identified application, and noted that an office action had issued following the Board of Patent Appeals and Interferences and Federal Circuit decisions in the case. He also noted that the examiner had not followed the Board's directive to address the deficiencies of the prior art rejection, as delineated by the Federal Circuit (to wit, the grammar creation processing capability recited in claims 11 and 14), but instead rejected the still-active claims in the case under 35 USC 112, second paragraph based upon the *Donaldson* decision and further under the first paragraph of 35 USC 112 for allegedly lacking enablement.

The undersigned had reviewed the entire record of this application, and concludes that the section 112 rejections are unfounded. As to the *Donaldson*-based rejection under 35 USC 112, second paragraph, while structure per se is not disclosed--this being primarily a software case--the acts for performing the recited functions clearly are. As to the enablement rejection, the undersigned agrees that the rejection is unconvincing, given the level of detail recited in the specification and particularly in view of the literature mentioned on the topic, for example the Wheatly article mentioned on page 8. Thus, it was agreed that the rejections should be withdrawn.

The case is being returned to the art unit for final consideration. Unless the Examiner has present knowledge of the existence of a particular reference(s) that provides clear and convincing evidence of the unpatentability of the claims at issue, the case shall be passed to issue.


Mark R. Powell
Director
Technology Center 2600

Neerings, Ronald

From: Powell, Mark [Mark.Powell@USPTO.GOV]
Sent: Monday, December 15, 2003 2:14 PM
To: Neerings, Ronald

Hi Ron, Unless a solid, unquestionable, bulletproof piece of art surfaces, a notice of allowance will be mailed by Friday. Did you receive the fax last week?

Mark

ATTACHMENT 8-3